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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/634,833  | 08/06/2003  | Toshinao Arai        | 8067-1001             | 8616             |
| 466   | 7590        | 12/13/2005           | EXAMINER              |                  |
| YOUNG & THOMPSON<br>745 SOUTH 23RD STREET<br>2ND FLOOR<br>ARLINGTON, VA 22202 |             |                      | LECHERT JR, STEPHEN J |                  |
|   |             |                      | ART UNIT              | PAPER NUMBER     |
|   |             |                      | 1732                  |                  |

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                    |                     |  |
|------------------------------|------------------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>             | <b>Applicant(s)</b> |  |
|                              | 10/634,833                         | ARAI ET AL.         |  |
|                              | Examiner<br>Stephen J. Lechert Jr. | Art Unit<br>1732    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-15 is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-17 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 August 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

**1. Applicant's arguments and timely filed terminal disclaimer have been fully and carefully considered. The timely filed and properly executed Terminal Disclaimer obviates the obviousness-type double patenting rejection. Upon reviewing the case, the method claims were deemed allowable. The examiner felt that the product by process claims may not be allowable because the product is known but made by a different process, in order to expedite prosecution on the merits, the examiner is requiring restriction/election between the process and the product as set forth below:**

**2. Restriction to one of the following inventions is required under 35 U.S.C. 121:**

- I. Claims 1-15, drawn to a solvent casting process, classified in class 264, subclass 216+.**
- II. Claim 16 , drawn to a cast film, classified in class 520, subclass 1+.**
- III. Claim 17, drawn to a display device containing the cast film, classified in class 349, subclass 1+.**

**The inventions are distinct, each from the other because of the following reasons:**

**3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product of the group II claims could be made by an extrusion process.**

**4. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the cast film of the group II claims can be used in devices or packaging and does not have be used in the display device as claimed in the Group III invention.**

**5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their**

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**different classification, restriction for examination purposes as indicated is proper.**

**6. Because these inventions are distinct for the reasons given above and the search required for any one Group is not required for the other Groups, restriction for examination purposes as indicated is proper.**

**7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).**

**8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Lechert Jr. whose telephone number is 571-272-1203. The examiner can normally be reached on 9:30-6:00.**

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**If attempts to reach the examiner by telephone are unsuccessful,  
the examiner's supervisor, Michael P. Colaianni can be reached on  
571-272-1196. The fax phone number for the organization where this  
application or proceeding is assigned is 571-273-8300.**

**Information regarding the status of an application may be  
obtained from the Patent Application Information Retrieval (PAIR)  
system. Status information for published applications may be  
obtained from either Private PAIR or Public PAIR. Status information  
for unpublished applications is available through Private PAIR only.  
For more information about the PAIR system, see [http://pair-  
direct.uspto.gov](http://pair-direct.uspto.gov). Should you have questions on access to the Private  
PAIR system, contact the Electronic Business Center (EBC) at 866-  
217-9197 (toll-free).**

  
**Stephen J. Lechert Jr.  
Primary Examiner  
Art Unit 1732**